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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,825	02/02/2004	Anthony Gabriel Volini	V-0001	9066
7590 Anthony G. Volini McCracken & Frank LLP Suite 2150 200 W. Adams Chicago, IL 60606		01/08/2007	EXAMINER WASSUM, LUKE S	
			ART UNIT 2167	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE		DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/769,825

Applicant(s)

VOLINI ET AL.

Examiner

Luke S. Wassum

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 20040716.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

The Invention

1. The claimed invention is a method for automatically renumbering patent claims.

Information Disclosure Statement

2. The Applicants' Information Disclosure Statement, filed 16 July 2004, has been received and entered into the record. Since the Information Disclosure Statement complies with the provisions of MPEP § 609, the references cited therein have been considered by the examiner. See attached form PTO-1449.

Drawings

3. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because drawing Figures 1A, 1B, 2A and 2B are of screenshots of a document window, and are of extremely poor quality, and furthermore because many of the drawings are hand drawn with writing of such poor quality as to be illegible in places. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheet(s) must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Regarding claim 5, this claim cites that reference numbers subsequent to the new claim number are increased by one. It is unclear whether the limitation 'subsequent to the new claim number' refers to the reference numbers included in all claims following the newly added claim, or (in view of the limitation of claim 6) the reference numbers whose value exceeds the value of the newly added claim number.

7. Furthermore, the limitation that the new claim number is added within the series conflicts with the limitation of parent claim 1 that the claim numbers are a series of integers, since a new integer claim number could not be added to the series without conflicting with another claim number.

8. Claim 6, fully incorporating the deficiencies of parent claim 5, is likewise rejected.

9. Regarding claims 7 and 8, both claims contain reference to the term 'the subsequent of the reference numbers', rendering the claims indefinite.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 1-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

12. Regarding claims 1-23, these claims recite the a medium and method for performing the automatic renumbering of patent claims, but fails to recite a tangible result, a requirement for compliance with the provisions of 35 U.S.C. § 101 for a process that can be interpreted as being implemented through software.

For a result to be tangible, it must be more than just a thought or a computation; it must have real-world value rather than an abstract result. See *GOTTSCALK, Comr. Pats. v. BENSON et al.* (US SupCt) 175 USPQ 673 at 676-77 (invention ineligible because it had "no substantial practical application"). For instance, an additional step that included storing the newly renumbered claims on a storage medium would render the claims statutory, since there would then be a tangible result, the updated document containing the newly renumbered claims. Claims 1 and 20, however, merely cite renumbering claim and reference numbers as the result.

13. Further regarding claims 1-16 and 19, these claims all cite a computer readable medium containing software. All claims including software must claim the software in combination with an appropriate medium to establish a statutory category of invention and enable any functionality to be realized in order for the claimed subject matter to be statutory.

The inclusion of dependent claim 16, including the limitation that the medium is memory, means that one possible embodiment of the claimed computer readable medium is memory. Since memory is not necessarily persistent, that is, since upon termination of the program any data held in memory would be lost, memory (and thus the claimed computer readable medium) does not constitute a medium that establishes a statutory category of invention.

Claims 17 and 18, however, citing an embodiment wherein the medium is a compact disc and floppy disk respectively, both constituting persistent memory, would not be rejected under this provision of 35 U.S.C. § 101.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-9, 16 and 19-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Tran (U.S. Patent Application Publication 2001/0049707).

16. Regarding claim 1, **Tran** teaches a computer readable medium having code for automatic renumbering of patent claims as claimed, comprising:

- a) a first identification component that identifies a series of claim numbers wherein the claim numbers are integers (see disclosure of the generation of a claim tree [as illustrated in drawing Figure 3B], rendering inherent the identification of claim numbers, paragraph [0061]);
- b) a second identification component that identifies a series of reference numbers that reference particular claim numbers of the series (see disclosure of the generation of a claim tree [as illustrated in drawing Figure 3B], rendering inherent the identification of reference numbers, paragraph [0061]); and
- c) a renumbering routine that renumbers particular of the claim numbers and reference numbers in an automated fashion without the need for the user to renumber the claim and reference numbers individually (see disclosure of the automatic renumbering of claims in paragraph [0061]).

17. Regarding claim 20, **Tran** teaches a computer-assisted method of automatically renumbering patent claims as claimed, the method comprising the steps of:

- a) obtaining a code having one or more identification components and a renumbering routine (see disclosure that the system is implemented as software, paragraph [0016]);
- b) using the one or more identification components to identify a series of claim numbers and a plurality of dependency reference numbers associated with particular claim numbers of the series in a document wherein the claim numbers and reference numbers are integers (see disclosure of the generation of a claim tree [as illustrated in drawing Figure 3B], rendering inherent the identification of claim numbers and reference numbers, paragraph [0061]);
- c) changing the quantity of claims within the series (see disclosure that the user can choose to add or delete claims, paragraph [0061, lines 6-8]; and
- d) renumbering claim numbers and any reference numbers with the renumbering routine in response to the change while maintaining cross-reference numbers in an automated fashion without the need for the user of the method to individually renumber the claim numbers and the reference

numbers within the series (see disclosure of the automatic renumbering of claims in paragraph [0061]).

18. Regarding claim 2, **Tran** additionally teaches a computer readable medium wherein the renumbering routine is an add claim routine (see disclosure that the user can choose to add claims, paragraph [0061, lines 6-8).

19. Regarding claim 3, **Tran** additionally teaches a computer readable medium wherein the renumbering routine is a delete claim routine (see disclosure that the user can choose to delete claims, paragraph [0061, lines 6-8).

20. Regarding claims 4 and 22, **Tran** additionally teaches a computer readable medium and method wherein the code enables the display of an add claim button on a computer display (see 'Add' button at the bottom of the Claims window, drawing Figure 3B).

The examiner notes that the quality of the drawings make distinguishing the 'Add' button in the drawing difficult; it is more distinguishable in drawing Figure 3B of continuation application 11/405,323, published as U.S. Patent Application Publication

2006/0190807, and also in Figure 3B of U.S. Provisional Application 60/185,644, upon which this application relies for priority. The provisional application also cites the presence of the 'Add' and 'Del' claim buttons in the specification on page 24, line 11.

21. Regarding claim 5, **Tran** additionally teaches a computer readable medium wherein a new claim number is added within the series and wherein the reference numbers subsequent to the new claim number are increased by one (see disclosure that the user can add a claim and then all other claims will be automatically adjusted and renumbered accordingly, paragraph [0061]).

22. Regarding claim 6, **Tran** additionally teaches a computer readable medium wherein the subsequent reference numbers have a value greater than or equal to the new claim number (see disclosure that the user can add a claim and then all other claims will be automatically adjusted and renumbered accordingly, paragraph [0061]).

23. Regarding claim 7, **Tran** additionally teaches a computer readable medium wherein upon deletion of one of the claims within the series, claim numbers subsequent to the one claim are decreased by one and subsequent of the reference numbers are

decreased by one (see disclosure that the user can delete a claim and then all other claims will be automatically adjusted and renumbered accordingly, paragraph [0061]).

24. Regarding claim 8, **Tran** additionally teaches a computer readable medium wherein the subsequent of the reference numbers decreased by one have a value greater than the one deleted claim number (see disclosure that the user can delete a claim and then all other claims will be automatically adjusted and renumbered accordingly, paragraph [0061]).

25. Regarding claims 9 and 23, **Tran** additionally teaches a computer readable medium and method wherein the code enables the display of a delete claim button on a computer display (see 'Del' button at the bottom of the Claims window, drawing Figure 3B).

The examiner notes that the quality of the drawings make distinguishing the 'Del' button in the drawing difficult; it is more distinguishable in drawing Figure 3B of continuation application 11/405,323, published as U.S. Patent Application Publication 2006/0190807, and also in Figure 3B of U.S. Provisional Application 60/185,644, upon which this application relies for priority. The provisional application also cites the presence of the 'Add' and 'Del' claim buttons in the specification on page 24, line 11.

26. Regarding claim 16, **Tran** additionally teaches a computer readable medium wherein the medium is memory (see disclosure that the system is implemented as software, paragraph [0016], the storage of a computer program in memory being inherently required to execute said program on a computer).

27. Regarding claim 19, **Tran** additionally teaches a computer readable medium wherein the code thereof includes a validate position routine that validates whether a cursor is positioned adjacent a claim number (see disclosure that the user can drag/drop claims and the claims will be automatically renumbered to show their new relationship, rendering inherent a routine to validate the position of the cursor, paragraph [0061]).

28. Regarding claim 21, **Tran** additionally teaches a method that is performed in conjunction with a word processor program (see disclosure that the system is a document drafting system that provides one or more screens to receive text input, Abstract).

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Claim Rejections - 35 USC § 103

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

31. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

32. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tran** (U.S. Patent Application Publication 2001/0049707) in view of **Alger et al.** (U.S. Patent Application 2004/0204946).

33. Regarding claim 24, **Tran** teaches software for automatic renumbering of patent claims as claimed, comprising:

- a) code having one or more identification components that identify a series of claim numbers and a plurality of dependency reference numbers that reference particular claim numbers in the series (see disclosure of the generation of a claim tree [as illustrated in drawing Figure 3B], rendering inherent the identification of claim numbers and reference numbers, paragraph [0061]); and
- b) a renumbering routine that responds to a change in the series wherein the renumbering routine remembers claim numbers of the series and renumbers particular dependency reference numbers as necessary to

preserve the referencing relationship of the claim numbers and reference numbers prior to the change and wherein the claim numbers are integers (see disclosure of the automatic renumbering of claims in paragraph [0061]).

Tran does not explicitly teach a method of providing said software over the Internet.

Alger et al., however, teaches a method of providing software to a user via the Internet comprising the steps of:

a) providing a website for distribution of code to the consumer (see disclosure that consumers are now using the Internet to purchase software, paragraph [0005], lines 1-2); and

b) delivering the code to the consumer (see disclosure that the software is delivered to the consumer, paragraph [0005], lines 1-2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to distribute software via the Internet, since this method of obtaining software is very convenient to the consumer (see paragraph [0005], lines 3-4).

34. Regarding claim 25, **Alger et al.** additionally teaches a method of providing software wherein the code is delivered to the consumer over the Internet (see disclosure that the software is delivered to the consumer by download directly through the Internet, paragraph [0005], lines 2-3).

35. Regarding claim 26, **Alger et al.** additionally teaches a method of providing software wherein the code is disposed on a medium and the medium is physically delivered to the consumer (see disclosure that the software is delivered to the consumer through the mail, paragraph [0005], line 2).

36. Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tran** (U.S. Patent Application Publication 2001/0049707) as applied to claims 1-9, 16 and 19-23 above, and further in view of **Newman** (U.S. Patent 5,774,833).

37. Regarding claim 10, **Tran** teaches a computer readable medium having code substantially as claimed.

Tran does not explicitly teach a computer readable medium wherein the code on the medium is downloaded into a word processing program.

Newman, however, teaches a computer readable medium wherein the code on the medium is downloaded into a word processing program (see disclosure that the patent analyzer is started via a facility such as a menu option in word processing program 208, col. 6, lines 13-15; see also disclosure that it would be possible to embed the methods for checking patent text entirely with a word processor, col. 6, lines 34-36).

It would have been obvious to one of ordinary skill in the art at the time of the invention to download code directly into a word processing program, since this approach would not require the additional complications of interprocess communications between the patent analyzer and the word processor (see col. 6, lines 27-33, as opposed to the combined programs and working memory disclosed at col. 6, lines 38-40).

38. Regarding claims 11-15, **Newman** additionally teaches a computer readable medium wherein the patent analysis software parses the claims in order to recognize patent numbers and reference numbers [dictating claim dependencies] according to the format and structure of claims required by the Manual of Patent Examining Procedure (see col. 9, line 46 through col. 10, line 6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to parse claims in order to ascertain the claim and reference numbers in accordance with the MPEP, since the MPEP dictates the format of claims, and so parsing the claims with the goal of analyzing claims and dependencies would require parsing the claims in accordance with the required format and structure of said claims.

39. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tran** (U.S. Patent Application Publication 2001/0049707) as applied to claims 1-9, 16 and 19-23 above, and further in view of examiner's **Official Notice**.

40. Regarding claims 17 and 18, **Tran** teaches a computer readable medium having code substantially as claimed.

Tran does not explicitly teach a computer readable medium wherein the medium is a compact disc or a floppy disk.

The examiner, however, takes **Official Notice** that it was obvious at the time of the invention to store software programs on media such as compact discs or floppy disks.

It would have been obvious at the time of the invention to store software programs on media such as compact discs or floppy disks, since these media are portable and facilitate the delivery of software from the software provider to an end user for installation and use on a local computer.

Conclusion

41. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rivette et al. (U.S. Patent 5,754,840) teaches a system for assisting in the preparation and analysis of a patent document.

Petruzzi et al. (U.S. Patent 6,049,811) teaches a machine and method for drafting a patent.

Takano et al. (U.S. Patent 6,434,580) teaches a system for preparing and drafting a patent specification.

Fogel et al. (U.S. Patent Application Publication 2004/0059567) teaches a method for checking the semantic and syntactic correctness of patent claims.

Tran (U.S. Patent Application Publication 2006/0059413) teaches a system and method for checking a claims document for antecedent basis.

Tran (U.S. Patent Application Publication 2006/0190807) teaches a system and method for checking a claims document for antecedent basis.

Pressman ("Patent It Yourself Software User's Guide") is a user's guide for a software package for use in preparing a patent application.

The Law Works ("The Examiner Software") is a description of a software package to assist in the preparation of a patent application.

Tran ("Specification, Drawings and Claims of U.S. Provisional Patent Application 60/185,644") is a provisional patent application.

Inventorprise, Inc. ("Frequently Asked Questions") is a FAQ document regarding PatentEase, a software package to assist in the preparation of a patent application.

AutoDocs ("IPDAS - Intellectual Property Document Assembly System") is a description of a software package to assist in the preparation of a patent application.

Patent Seminars ("MightyMacro Patent Helper Software") is a description of a software package to assist in the preparation of a patent application.

Brux Software ("iClaim: A Patent Prosecutor's Aid") is a description of a software package to assist in the preparation of a patent application.

Brux Software ("iClaim Tutorial") is a tutorial on the iClaim software package.

Patent Prodigy ("Document Creation - Error Checking - Drafting Tools - Litigation Tools") is a description of a software package to assist in the preparation of a patent application.

Law Office Computing ("iClaim") is a product review of the iClaim software.

LexisNexis ("New LexisNexis PatentOptimizer Toolbar Simplifies and Fortifies Patent Drafting and Litigation") is a product announcement.

IPT Co. ("Patent Wizard") is a description of a software package to assist in the preparation of a patent application.

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Patent Seminars ("MightyMacro Patent Helper") is a description of a software package to assist in the preparation of a patent application.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119. Such communications must be clearly marked as INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (571) 273-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Luke S. Wassum
Primary Examiner
Art Unit 2167

lsw
4 January 2007